

REMARKS/ARGUMENTS

Claims 2-6 and 15-47 are canceled. Claim 1 is amended without adding new matter. Claims 48-49 are new. Support for claim 48 is found in the positive recitation of wortmannin derivatives or analogs along with other phosphatidylinositol 3-kinase (PI3K) inhibitors in the specification and the claims as originally presented. See MPEP 2173.05(i), "Negative Limitations" ("If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims"). Support for claim 49 is found throughout the specification as filed, e.g., at Example 5 (paragraphs 55-56) and Figures 6 and 7A-B of the published application, U.S. Patent Publication No. 2004/0072766. As such, no new matter is added with new claims 48 and 49.

Upon entry of this response, claims 1, 7-9, 48 and 49 are under examination. No new matter is introduced by this Response, and thus entry thereof is respectfully requested.

I. Examiner Interview

Applicant is greatly appreciative to Examiner Leavitt for attending the telephonic Examiner Interview held on January 29, 2010. During the interview, the Examiner and Applicant's representatives Karen Wong, Esther Kepplinger and Jeff Thomas discussed amendments provided herein to overcome the cited art. The Examiner's comments were very helpful to Applicant in preparing this response.

II. Rejoinder

Previously, the Examiner required restriction between six groups of claims. Applicant provisionally elected Group I (claims 1-6, 8-9 and 15-22) and traversed on the grounds that Group I, Group II (claims 1-6, 10-12 and 15-22) and Group III (claims 1-6 and 13-22) are classified in the same class and subclass. Furthermore, Applicant pointed to claim 7 as a generic claim which links Groups I, II and III. Group I has been under examination thus far. Upon entry of this response, if claim 7 is found allowable, Applicant respectfully requests rejoinder of withdrawn claims 10-14

from Groups II and III. These claims require use of the method of claim 7 and include at least the limitations thereof.

III. Claim Rejection under 35 U.S.C. §102

The Examiner rejected claims 1, 3 and 22 under 35 U.S.C. §102(e) as being allegedly anticipated by U.S. Patent 5,504,103, hereinafter “Bonjouklian.” Applicant traverses the rejection but has amended the claims solely in order to expedite prosecution. Claims 3 and 22 are canceled and thus rejections thereto are moot.

Claim 1 has been amended to recite that the subject suffers from one or more defined diseases, namely rheumatoid arthritis or allergy. Support for the amendment is found in the Application as filed, e.g., at least at paragraph 32 of the published application, U.S. Patent Publication No. 2004/0072766. In contrast, Bonjouklian discloses that “an especially preferred embodiment of the present invention includes a method of treat phosphatidylinositol 3-kinase-dependent neoplasms, particularly various lymphosarcomas...” See Bonjouklian, col. 6, lines 10-13. The reference further discloses that “PI 3-kinase-dependent conditions include biochemical processes relevant to pain, diabetes, inflammation, platelet aggregation, vascular diseases such as atherosclerosis, restenosis, and the like...” Id., lines 5-8.

Because Bonjouklian discloses nothing about treating rheumatoid arthritis or allergy, the reference does not anticipate the claimed invention. Moreover, Bonjouklian does not even hint at treating these diseases but rather is focused on treating certain cancers and other unrelated diseases.

For at least the reasons stated above, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §102(e).

IV. Claim Rejection under 35 U.S.C. §112

The Examiner rejected claims 1, 3, 7, 15, 17, 19 and 22 under 35 U.S.C. §112, first paragraph “[t]o the extent that [the claims] broadly embrace an in vivo method of treating a human subject

suffering from an autoimmune condition comprising inducing unresponsiveness to an antigen in a T cell wherein the antigen is an autoantigen so as to treat an inappropriate immune response against its own tissues.” Office Action, p. 5. The Examiner acknowledges that the specification is enabling for “[a]n in vitro method for inhibiting T cell activation as assessed by production of IL-2 comprising stimulating a T cell through the TCR/CD3 complex and CD28 and further contacting said T cell with an agent wherein the agent is selected from the group consisting of Wortmannin, quercetin and LY294002, thereby inhibiting the activity of phosphatidylinositol 3-kinase in the T cell...” Office Action, p. 5. However, the Examiner alleges that “[t]here is nothing in the specification teaching that inhibition of T cell activation can affect autoimmune disorders regardless of the etiology of the disease.” Id.

Applicant traverses the rejection but has amended the claims solely in order to expedite prosecution. Claims 3, 15, 17, 19 and 22 are canceled with this Response and thus the rejections thereto are moot. Claim 1 has been amended to recite that the subject suffers from one or more defined diseases, namely rheumatoid arthritis or allergy. One of skill would have understood at the time of filing that rheumatoid arthritis or allergy would benefit from an agent that downmodulates an immune response by inhibiting T-cell activation as taught by Applicant’s invention.

For at least the reasons stated above, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §112, first paragraph.

V. Obvious Type Double Patenting

The Examiner rejected claims 1, 3, and 7-9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 7-10 of U.S. Patent No. 6,632,789.

Applicant respectfully notes that the aforementioned claims in U.S. Patent No. 6,632,789 contain patentably distinct elements that are not present in the claims as currently amended of the instant application, and vice versa.

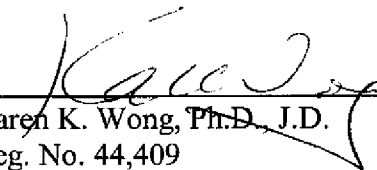
CONCLUSION

Applicant submits that this paper fully addresses the Final Office Action mailed April 9, 2009. An earlier issuance of Notice of Allowance is earnestly requested. Should the Examiner have any questions, the Examiner is encouraged to contact the undersigned attorney at (650) 849-3383. The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees, to Deposit Account No. 23-2415 (Docket No. 35280-730.401).

Respectfully submitted,

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By: _____


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